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10/635,624

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Adam Sommer

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EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

01/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,624

Applicant(s)

SOMMER, ADAM

Examiner

WILLIAM E. RANKINS

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) 1-24, 37-72 and 90-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-36 and 73-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/22/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election with traverse of Group II in the reply filed on 12/20/2007 is acknowledged. The traversal is on the ground(s) that "The official action fails to show how steps such as 'storing of the offer by a first user of the exchange system' and 'wherein the storing step uses a database to store the offer' are present in such a flea market or would be performed by a materially different apparatus or by hand". This is not found persuasive because the examiner asserts that a flea market is an exchange system and a database is defined as a collection of data arranged for ease and speed of search and retrieval per the American Heritage Dictionary, 4th Edition, 2004. Therefore, a database may be construed as information written on 3 x 5 cards or kept in a file folder.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-24, 37-56, 57-72, 90-113 and 114-122 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/20/2007.

3. This application contains claims 1-24, 37-56, 57-72, 90-113 and 114-122 are drawn to an invention or inventions nonelected with traverse in the reply filed on 12/20/2007. A complete reply to the final rejection must include cancellation of

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nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. The examiner assumes that by election in the reply filed on 12/20/2007 all non-elected claims are withdrawn and as such will proceed with a first action on the merits.

Detailed Action

The examiner asserts that claims 25 and 73 do not invoke U.S.C. 112 6th paragraph although 'means for' language is used. This is evidenced by the recitation of sufficient structure in the subsequent claims, e.g. database, computer software, etc.

The examiner asserts that claim 29 does not invoke U.S.C. 112 6th paragraph as it is dependent upon and therefore includes all the limitations of claim 25.

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claims 25-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins et al. (2003/0028476).

As per claim 25;

Jenkins et al. discloses:

An exchange system comprising:

means for allowing a first user to offer a first amount of a first article of commerce in trade for a second amount of a second article of commerce, wherein the first user has the first amount of the first article of commerce in an escrow account; and means for allowing a second user to accept the offer of the first user (paragraphs 0021 and 0031).

As per claim 26;

Jenkins et al. discloses:

The system of claim 25, wherein the allowing to offer means includes a database to store the offer of the first user (paragraph 0021).

As per claim 27;

Jenkins et al. discloses:

The system of claim 25, wherein the allowing to offer means includes computer software (paragraphs 0021 and 0044).

As per claim 28;

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Jenkins et al. discloses:

The system of claim 25, wherein the allowing to accept means includes computer software (paragraphs 0021 and 0044).

As per claim 29;

Jenkins et al. discloses:

The system of claim 25, further comprising means for allowing ownership of the first amount of the first article of commerce to be transferred to the second user and for ownership of the second amount of the second article of commerce to be transferred to the first user (paragraphs 0021 and 0031).

As per claim 30;

Jenkins et al. discloses:

An exchange system comprising an offer-storing database, the database being configured to store offers to trade amounts of articles of commerce for amounts of other articles of commerce, the articles of commerce being held in escrow accounts and the offers being selectable by a second user (paragraphs 0021 and 0031).

As per claim 31;

Jenkins et al. discloses:

The exchange system of claim 30, wherein offers selected by the second user can then be accepted by the second user (paragraphs 0021 and 0022).

As per claim 32;

Jenkins et al. discloses:

The exchange system of claim 31, wherein the accepted offers are removed from the offer-storing database (paragraph 0038).

As per claim 33;

Jenkins et al. discloses:

The exchange system of claim 30, wherein the offers stored in the database are created by a first user (paragraph 0022).

As per claim 34;

Jenkins et al. discloses:

The exchange system of claim 33, wherein the first user is associated with an escrow account containing the articles that the first user is offering to trade (paragraph 0021 and 0022).

As per claim 35;

Jenkins et al. discloses:

A method in a computer system for exchanging articles of commerce, the method comprising the steps of:

receiving, over a communication network from a first client, a transmission of an

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offer to exchange a first amount of a first article of commerce for a second amount of a second article of commerce, the first client having the first amount of the first article of commerce in a first escrow account (paragraph 0031);

storing the offer; permitting the offer to be communicated to a second client; and receiving, over the communication network from the second client, a transmission of an acceptance of the offer, the second client having the second amount of the second article of commerce in a second escrow account (paragraph 0021).

As per claim 36;

Jenkins et al. discloses:

The method of claim 35, wherein, upon completion of the receiving an acceptance step, the system transfers articles from the first account to the second account and from the second account to the first account (paragraph 0021).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

2. Claims 73-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins et al. (2003/0028476) as applied to claims 25-36 above, and further in view of Shepherd (5,748,731).

As per claim 73;

Jenkins et al. does not disclose:

An electronic exchange system comprising:

means for allowing a first user to offer a first amount of a first non-currency article of commerce in trade for a second amount of a second non-currency article of commerce; and means for allowing a second user to accept the offer of the first user.

However, Shepherd discloses:

Trading of electronic trading cards between collectors (Col. 1, lines 4-8, Col. 2, lines 12-15 and lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Jenkins et al. and Shepherd.

One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to provide a means for traders to ensure that a collector is not receiving duplicated electronic trading cards by going through an intermediary clearing house which stores and settles the trades for the users.

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Claim 74 is rejected under the same rationale used to reject claims 26 and 73.

Claim 75 is rejected under the same rationale used to reject claims 27 and 73.

Claim 76 is rejected under the same rationale used to reject claims 28 and 73.

Claim 77 is rejected under the same rationale used to reject claims 29 and 74.

Claim 78 is rejected under the same rationale used to reject claims 30 and 73.

Claim 79 is rejected under the same rationale used to reject claims 31 and 73.

Claim 80 is rejected under the same rationale used to reject claims 32 and 73.

Claim 81 is rejected under the same rationale used to reject claims 33 and 73.

Claim 82 is rejected under the same rationale used to reject claims 34 and 73.

Claim 83 is rejected under the same rationale used to reject claims 35 and 73.

Claim 84 is rejected under the same rationale used to reject claims 30 and 73.

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Claim 85 is rejected under the same rationale used to reject claims 36 and 73.

Claim 86 is rejected under the same rationale used to reject claim 73.

As per claim 87;

Jenkins et al. discloses:

The method of claim 86, further comprising the step of providing for notifying the first user and the second user of the exchange Paragraph 0025).

As per claim 88;

Jenkins et al. does not disclose:

The method of claim 86, further comprising the step of providing for verifying that the first amount of the first non-currency article of commerce is available to be traded.

However, Shepherd discloses:

A trading method where the article to be traded is electronically loaded to a temporary storage medium (Col. 7, lines 53-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Jenkins et al. and Shepherd. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to take advantage of the availability of a clearinghouse or third party to settle the transaction thereby ensuring that the transaction is legitimate.

Claim 89 is rejected under the same rationale used to reject claim 88.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/
Examiner, Art Unit 3694

/THOMAS A DIXON/

Supervisory Patent Examiner, Art Unit 3694